

REMARKS

Status of the Application

Claims 1-7, 11-17, 19 and 21-27 are all the claims that have been examined in the application. Claim 23 stands rejected under a preliminary double patenting rejection. Claims 1, 3-5, 7, 11, 13-15, 17, 19 and 21-25 stand rejected under 35 U.S.C. § 103(a) as being obvious over JP 62-184357 in view of Knobel (U.S. 5,482,863). Claims 2 and 12 are rejected under 35 U.S.C. §103(a) as assertedly being unpatentable over JP 62-184357 in view of Knobel as applied to Claims 1 and 11 respectively above, and further in view of JP 64-27626. Claims 6, 16, 26 and 27 stand rejected under 35 U.S.C. §103(a) as assertedly being unpatentable over JP 62-184357 in view of Knobel as applied to Claims 1 and 11 respectively above, and further in view of Makino et al (U.S. Patent No. 5,555,767).

By this Amendment, Applicants are amending claim 25.

Double Patenting Rejection

The Examiner asserts that if claim 24 is allowed, claim 25 will be objected to under 37 C.F.R. § 1.75 as being a substantial duplicate thereof.

Applicants have corrected the noted deficiency. Withdrawal of the preliminary rejection is hereby respectfully requested.

Claim Rejections – 35 U.S.C. § 103

A. *Claims 1, 3-5, 7, 11, 13-15, 17, 19, and 21-25 are rejected under 35 U.S.C. §103(a) as assertedly obvious over JP 62-184357 in view of Knobel (U.S. Patent No. 5,482,863).*

Applicants respectfully submit that there is no motivation to combine the references as alleged by the Examiner. JP '357 relies on the motion of the pipette in the vertical direction to create mixing of two separate liquids. JP '357 also relies on the motion of the pipette in the only vertical direction (not horizontally different position) to create mixing. But, in the claimed invention, stirring is carried out with the suction and discharge by automatic control at the horizontally different positions to obtain the unexpectedly excellent effects, which is different from JP '357. Knobel discharges a reagent into a vessel to dislodge particles which have adhered to the wall of the otherwise empty vessel. The process in Knobel results in the particles being suspended in the reagent. Because the disclosure in JP '357 is not concerned with the suspension of particles, and because Knobel fails to concern itself with the mixing of liquids already present in the liquid-containing container, one of ordinary skill in the art would not be motivated to combine the references.

The Examiner argues that the motivation to combine the references stems from Knobel providing more effective mixing and reducing the need for shaking the container for adequate mixing. This motivation is unsubstantiated. JP '357 does not require that an additional shaking procedure must be used to effectively mix the two liquids. Additionally, the Examiner fails to provide any objective evidence taken from the references themselves which would lead one skilled in the art to the claimed invention. The burden is on the Examiner to demonstrate using only objective evidence or suggestion *from the applied prior art*, that one of ordinary skill would have been lead to the claimed invention as a whole without recourse to Appellant's disclosure. See: *In re Oetiker*, 977 F.2d 1443, 1447-48, (Fed. Cir. 1992); *In re Fine* 837 F.2d 1071, 1074-75,

(Fed. Cir. 1988) (emphasis added). As a matter of law then, it is the burden of the Examiner to demonstrate that *the prior art*, and not Appellant's disclosure, *would lead the hypothetical artisan to the claimed invention as a whole*. Therefore, because the Examiner has failed to provide any objective evidence that the references may be combined, the Examiner has not met the burden required in establishing a *prima facie* case of obviousness with regard to claims 1 and 11. Claims 1 and 11 are patentable.

Claims 3-5, 7, 13-15, 17, 19 and 21-25 are patentable at least by virtue of their dependency from claim 1 and 11, respectively.

B. Claims 2 and 12 are rejected under 35 U.S.C. §103(a) as assertedly being unpatentable over JP 62-184357 in view of Knobel as applied to Claims 1 and 11 respectively above, and further in view of JP 64-27626.

Claims 2 and 12 are patentable at least by virtue of their dependency, as JP '626 fails to cure the defects noted in the rejection of claims 1 and 11 with regard to the combination of JP '357 and Knobel.

C. Claims 6, 16, 26 and 27 are rejected under 35 U.S.C. §103(a) as assertedly being unpatentable over JP 62-184357 in view of Knobel as applied to Claims 1 and 11 respectively above, and further in view of Makino et al (U.S. Patent No. 5,555,767).

Claims 6, 16, 26 and 27 are patentable at least by virtue of their dependency, as Makino fails to cure the defects noted in the rejection of claims 1 and 11 with regard to the combination of JP '357 and Knobel.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

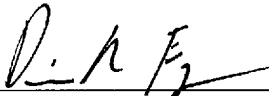
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